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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/448,420	11/22/1999	MICHAEL SEUL	42970-3	5017

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EXAMINER

PONNALURI, PADMASHRI

ART UNIT PAPER NUMBER

1639

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/448,420

Applicant(s)

SEUL ET AL.

Examiner

Padmashri Ponnaluri

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 129-151, 154-166 and 168-174.Claim(s) withdrawn from consideration: 152-153, 167.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Padmashri Ponnaluri
Primary Examiner
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ADVISORY ACTION (continued)

The after final response filed on 10/17/03 has been fully considered but does not overcome the rejections of record.

Applicant's response does not overcome the rejection of claims 129-151, 160-166, 168-174 under 35 U.S. C. 102 (b) as being anticipated by Boyce et al for the following reasons.

Applicants argue that in Boyce et al the solid support of interest is isolated from other solid supports, which would not read on the instant claim limitation 'in-situ optical interrogation of the tag.' Applicant's arguments have been considered and are not persuasive.

Examiner agrees with applicants response in page 4, the instant claim 129 recites that 'tag is decoded by in-situ optical interrogation to identify the compound ' however, the word **"identify"** the compound does not include determining the sequence or structure of the compound' as in applicants arguments. Applicants argue that the 'the sequence or structure of the compound is also necessarily determined by the recited in-situ optical interrogation.' Applicants arguments have been considered since the word 'identify' does not include determining the structure or sequence of the compound, and the reference identifies the (by picking up) the bright red beads, which have the compound of interest present. Thus, the reference identified the compound or the bead with the compound by in-situ optical interrogation. If applicants mean 'identifying the compound by in-situ optical interrogation' applicants are requested to amend the claim to include the limitations.' In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the sequence or the structure of the compound is determined by the in-situ optical interrogation) are not recited in the rejected claim(s). Although

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the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's response does not overcome the rejection of claims over WO 93/06121 (Dower et al) for the following reasons.

Applicants argue that 'Dower et al teach after the receptor assay the positive beads are identified by visual inspection of the fluorescent beads.' Applicants argue that the decoding methods described in Dower et al involve the isolation of the beads to be decoded. Applicants arguments have been fully considered and are not persuasive, because as discussed in the supra response the phrase 'identifying the compound by in-situ optical interrogation' does not include determining the structure or sequence of the compound. The reference identifies the fluorescent beads manually which would read on 'in-situ optical interrogation' of the instant claims. If applicants mean that the 'identifying the compound by in-situ optical interrogation' includes determining the structure or the sequence applicants are requested to amend the claims.

Applicant's response does not overcome the rejection of claims over Still et al for the following reasons.

Applicants argue that the reference method of decoding step is not carried out without isolating the solid support of interest from other solid supports as in the instant claims. Applicants arguments have been fully considered and are not persuasive, since the reference teaches that the fluorescent beads with the compounds of interest are identified manually which would read on the 'identifying the compound by in-situ optical interrogation' of the instant claims.

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Applicant's response does not overcome the obviousness rejection of claims over Dower et al and Matzekar for the following reasons.

Applicant's arguments have been fully considered and are not persuasive for the reasons discussed supra, and further the response is based on the individual references. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The rejection is based on the combined teachings of Dower et al and Matzekar et al. Applicants further argue that Dower et al teachings are teaching away from the claimed invention. Applicant's arguments have been considered and are not persuasive, since Dower et al teach the use fluorescent tags, the tags other than the oligonucleotide tags as in applicant's arguments. Thus the rejections of record have been maintained for the reasons of record.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Padmashri Ponnaluri whose telephone number is 703-305-3884. The examiner is on Flex Schedule and can normally be reached from Monday through Friday between 7.30 AM and 4.00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 703-306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0916.

Padmashri Ponnaluri
Primary Examiner
Art Unit 1639

Pp
11/5/03


PADMASHRI PONNALURI
PRIMARY EXAMINER